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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|-----------------------------------|------------------|
| 10/798,201 | 03/10/2004 | Andrew McPherson Downie | 85170-4599 | 6184 |
| 28765 | 7590 | 09/22/2006 | | |
| WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006 | | | | |
| | | | EXAMINER GAY, JENNIFER HAWKINS | |
| | | | ART UNIT 3672 | PAPER NUMBER |

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/798,201 | Applicant(s) DOWNIE ET AL. | |
| | Examiner Jennifer H. Gay | Art Unit 3672 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 is/are allowed.
- 6) ☒ Claim(s) 31, 32, 34, 35, 39, 40 and 42-58 is/are rejected.
- 7) ☒ Claim(s) 33, 36-38, 59 and 60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 31, 32, 34, 35, 39, 40, and 48-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Makohl (US 4,485,880).

Regarding claims 31, 32: Makohl discloses a downhole tool for used with a downhole tool assembly. The tool includes the following features:

- A first body **1** and a second body **7** that are mounted for relative rotation.
- A joint part adapted to form a selectively releasable joint between the second body and a part of the assembly couplable to the second body (not shown; the examiner notes that the second body is connected conventionally to a drill bit (1:10-22, 3:8-10)).
- A locking means **13** for locking the first and second bodies relative to one another against relative rotation. The locking of the bodies relative to one another facilitates a release force through the first body to the joint to release the joint and thus separate the tool from the part of the assembly. (1:10-22, 3:55-68; though the release is not specifically recited, it is stated that the drill pipe is rotated in the reverses direction which would inherently disconnect the stuck drill bit).

Regarding claim 34: The tool assembly includes a downhole drilling assembly (not shown) and the tool includes a drilling motor **2, 3** to drive a drill bit of the assembly.

Regarding claim 35: Makohl discloses a drilling assembly that includes the following features:

- A drill bit (not shown).
- A downhole drilling motor that has a body 1 for coupling the tubing of the assembly and a rotatable drive shaft 7 for coupling to the drill bit.
- A selectively releasable joint (not shown) located between the motor and the drill bit.
- A locking means 13 for locking the drive shaft to the motor body. The locking of the bodies relative to one another facilitates a release force through the first body to the joint to release the joint and thus separate the tool from the part of the assembly. (3:55-68; though the release is not specifically recited, it is stated that the drill pipe is rotated in the reverse direction which would inherently disconnect the stuck drill bit).

Regarding claims 39, 56: The joint is located between the drive shaft and the drill bit to allow separation of it from the remainder of the assembly.

Regarding claims 40, 48: The joint is a conventional joint thus is a cylindrical, threaded, pin and box connection.

Regarding claim 49: The locking means includes locking members that engage the motor to lock the shaft to the body of the motor.

Regarding claims 50-52, 57, 58: The locking members are placed in the string of the assembly at the surface to transport to a chamber 14 in the within the motor. The locking means are locking balls.

Regarding claims 53, 54: The motor can be a fluid drive turbine or a positive displacement motor.

Regarding claim 55: Makohl discloses a method for selectively releasing a drill bit using the above tool. The method involves the following steps:

- Providing the assembly.
- Activating the locking means.
- Applying a rotational release force to the tubing of the assembly and the motor body to release the joint and separate the motor from the bit.
- Recovering the remainder of the assembly to the surface.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makohl.

Though Makohl does not disclose the motor shaft having a male pin and the drill bit having a female box, however, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the assemblies of Makohl with the appropriate box/pin relationship as a box to a pin would have unthreaded the same as a pin to a box and designing the assembly with either relationship would have been within the ability of one of ordinary skill in the art since applicant has not disclosed that particular relationship claims solves any stated problem or is for any particular purpose and it appears that the invention would equally well with any box/pin relationship.

Allowable Subject Matter

5. Claim 41 is allowed.
6. Claims 33, 36-38, 59, and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. In view of applicant's amendment, the objection to the drawings has been withdrawn.
8. Applicant's arguments filed June 6th, 2006 have been fully considered but they are not persuasive.

Applicant has argued that Makohl does not disclose the release of a selectively releasable joint between the second body part and a part of the assembly couplable to the second body, so as to separate the tool from the part of the assembly. Applicant further disagrees with the examiner's assertion that Makohl inherently teaches these features.

In response the examiner first notes that Makohl specifically states that the second body or drive shaft is connected to a drill bit (1:10-22 and 3:8-10). As the drill bit is not formed as an integral part of the drive shaft, formed of the same body, then the drill bit must be connected to the second body by a releasable joint. Secondly, column 1, lines 10-22 does indicate that it is desirable to release the drive shaft from the bit when the bit becomes stuck and that the assembly disclosed in the patent is a means for doing so.

9. Applicant's arguments with respect to claims 33, 36-38, 59, and 60 have been fully considered and are persuasive. The rejection of those claims has been withdrawn.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

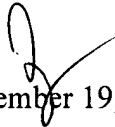
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer H Gay
Primary Examiner
Art Unit 3672

JHG 
September 19, 2006